



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/056,584

01/24/2002

Gerhard Pfeifer

5005.1018

4703

23280

7590

04/21/2003

DAVIDSON, DAVIDSON & KAPPEL, LLC
485 SEVENTH AVENUE, 14TH FLOOR
NEW YORK, NY 10018

EXAMINER

PRITCHETT, JOSHUA L

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 04/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AL

Office Action Summary

Application No.

10/056,584

Applicant(s)

PFEIFER, GERHARD

Examiner

Joshua L Pritchett

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☒ Claim(s) 1-6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

Claims 1-5 is objected to because of the following informalities:

Claim 1 the phrase “for the specimen slide are form at the rim” is difficult to understand” the examiner will treat the claim as if the quoted limitation means the specimen slide to contact both the support surfaces and the abutment surface. Claims 2-5 inherit the deficiencies of claim 1 and are therefore also objected to.

Claim 4 also does not end with a period.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Georges (US 4,248,498).

Art Unit: 2872

Regarding claim 1, Georges discloses a baseplate (35), retainable on the microscopic stage (Fig. 1), in which is configured, for reception of the specimen slide (Fig. 6), an opening (45) with a rim (Fig. 6). The opening of Georges is further discussed in col. 6 lines 1-4. Georges further discloses flat support surfaces (21 and 21') and at least one abutment surface (27), extending substantially perpendicular to the support surface (Fig. 6), for the specimen slide are formed at the rim (Fig. 6). The flat support surfaces (the top surface on which the slide rests of 21 and 21' as seen in Fig. 6) and the at least one abutment surface (the vertical face of 27 adjacent the slide) extend perpendicular to one another. Georges further discloses at least one spring element (48) with which the specimen slide arranged in the opening (45) of the baseplate (35) is pressed against the at least one abutment (27) surface of the opening, wherein the at least one abutment surface of the opening is configured in such a way that it exerts, on the specimen slide that is pressed against the abutment surface, a force component directed substantially downward onto the support surface of the opening (col. 5 lines 24-26). The slide is pressed against the at least one abutment surface of in the Georges reference when the movable structure (19) is slid to the left as indicated by the arrows in Fig. 6.

Regarding claim 2, Georges discloses the at least one abutment surface of the opening is configured in such a way that the side of the specimen slide resting against it makes contact only in a region spaced away from the support surface and arranged above the horizontal center line of the specimen slide (col. 5 lines 24-26). By the slide engaging an undercut abutment surface the slide must inherently contact the abutment surface in a region spaced away from the support surfaces.

Art Unit: 2872

Regarding claim 3, Georges discloses an undercut, which cuts away the contact region with the specimen slide, is configured in the abutment surface in the transition region from the support surface to the abutment surface (col. 5 lines 24-26).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Georges in view of Official Notice.

Georges teaches the invention as claimed, but lacks specific reference how the undercut of the abutment surfaces (27) is made. Official Notice teaches that it is well known in the art to use either a conical milling cutter or a drilling method to create the undercut in a plastic or metal material (which are common materials used in microscopes). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use either drilling or a conical milling cutter to create the undercut in the abutment surface of Georges for the purpose of creating an undercut with precise dimensions with ordinary equipment in order to reduce production costs.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Georges.

Georges discloses an X-Y microscope stage defining a stage surface (Fig. 6). Georges further discloses a holder, arranged above the stage surface of the X-Y microscope stage and being positionable in X and Y directions (col. 12 lines 33-34), for positioning the specimen slide. Georges further discloses an opening for the specimen slide is formed in a baseplate (35) of the holder, wherein the opening is configured with support surfaces (21 and 21') and abutment surfaces (27) for the specimen slide. Georges further discloses a spring element (48) is mounted on the specimen slide for pressing the specimen slide against the abutment surface of the opening so that the specimen on the specimen slide is located opposite the stage surface (Fig. 6). Georges lacks specific reference to a specimen collection device, however Georges teaches that such a device is known and used in the art. Georges further teaches a collection device having at least one container for collecting a specimen that has be cut out, wherein the collection device being conveyable to an opening working space configured between the holder and the stage surface (col. 1 lines 17-21). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the Georges invention include a specimen collection device for the purpose of preserving the specimen for further analysis at a later date.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Georges in view of Hellmuth (US 5,795,295).

Georges discloses the invention as claimed and discussed in the rejection of claim 6, but lacks reference to the use of an apparatus for laser cutting the specimen. Hellmuth teaches the

Art Unit: 2872

use of an apparatus for laser cutting the specimen in a microscope (col. 11 lines 67 – col. 12 line 2). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the Georges invention include the laser cutting apparatus as taught by Hellmuth for the purpose of removing pieces of the specimen to examine a cross section of the specimen or reduce the size of the specimen.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Georges (US 4,367,915) teaches an adjustable microscope the undercut abutment surfaces.

Bloomfield (US 3,572,889) teaches a microscope with undercut abutment surfaces.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua L Pritchett whose telephone number is 703-305-7917. The examiner can normally be reached on Monday - Friday 7:00 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou can be reached on 703-308-1687. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9318 for regular communications and 703-872-9319 for After Final communications.

Application/Control Number: 10/056,584

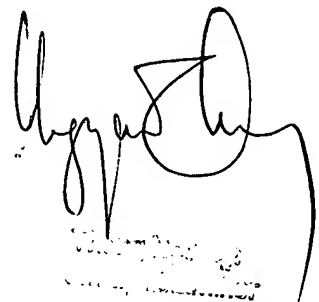
Page 7

Art Unit: 2872

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

JLP

April 16, 2003

A handwritten signature in black ink, appearing to be "Cheng" followed by a stylized flourish.